

REMARKS

INTRODUCTION:

In accordance with the foregoing, claim 18 has been cancelled without prejudice or disclaimer, and claims 1, 17, 19, and 33 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-17, and 19-34 are pending and under consideration.

Claims 1-3, 10-11, 14-19, 21, 22, 24-29, and 32 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ueda et al., (US 6,314,064 – hereinafter Ueda). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claims 4, 6-7, 9, 23, 33, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ueda. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claims 5, 8, 12, 13, 30, and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ueda and further in view of Nagashima et al., (US 6,304,526 – hereinafter Nagashima). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ueda and further in view of in view of the Description of the Related Art of the Specification. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

The MPEP states: “[t]o anticipate a claim, the reference must teach every element of the claim.” (MPEP 2131).

The MPEP then quotes: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes “[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

And as a general matter, to establish a *prima facie* obviousness rejection, the Office Action needs to provide evidence of the existence of individual elements corresponding to the recited limitations, a motivation to combine the individual elements to create the recited invention, and a reasonable expectation of success. (See MPEP, at 2143 – “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.’ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”, and at 2143.03 – “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.’ *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”).

Applicants respectfully submit that the subject matter of claim 18 has been incorporated into independent claims 1, 17, and 33.

Amended, independent claim 1 recites: “...wherein the first objective lens forms a first numerical aperture for use with the first recording medium and a second numerical aperture other than the first numerical aperture for use with the second recording medium, and the second objective lens forms a third numerical aperture which is other than the first and second numerical apertures for use with the third recording medium.”

Amended, independent claim 17 recites: “...the first objective lens forms a first numerical aperture for use with the first optical medium and a second numerical aperture other than the first numerical aperture for use with the second optical medium, and the second objective lens forms a third numerical aperture which is other than the first and second numerical apertures for use with the third optical medium.”

And amended, independent claim 33 recites: “...the first objective lens forms a first numerical aperture for use with the first optical medium and a second numerical aperture other than the first numerical aperture for use with the second optical medium, and the second objective lens forms a third numerical aperture which is other than the first and second numerical apertures for use with the third optical medium.”

Ueda discloses objective lens unit 22 (for third optical disc 8) with a numerical aperture (NA) of not less than 0.7, and gives a specific example of 0.85. (See Ueda, at col. 5, lines 1-3). But since Ueda does not disclose any numerical aperture for objective lens 34 for either of the lights emitted from laser coupler 31, Applicants respectfully submit that the Office Action has presented no evidence to support the assertion that that the NA of objective lens unit 22 used for third optical disc 8 is different from two NAs for objective lens 34.

Further, though Ueda discloses using NA of 0.85 with the third optical disc 8, Ueda neither discloses nor suggests an exclusivity of this NA. In other words, since Ueda is silent as to the NA of objective lens 34, Ueda neither discloses nor suggests that the NA of 0.85 is not usable with objective lens 34. In fact, Ueda even suggests that the same wavelength (635 nm) can be used for both the second and third optical discs 7 and 8. (See Ueda, at col. 4, lines 60-63, and col. 10, line 35-38).

Applicants respectfully submit that Ueda neither discloses nor suggests "...the first objective lens forms a first numerical aperture for use with the first optical medium and a second numerical aperture other than the first numerical aperture for use with the second optical medium, and the second objective lens forms a third numerical aperture which is other than the first and second numerical apertures for use with the third optical medium." Thus, Ueda fails to disclose every element of the claims, arranged as required by the claims.

Applicants respectfully submit that Nagashim fails to cure these defects.

Accordingly, Applicants respectfully submit that the Office Action has not provided sufficient evidence to maintain a prima facie anticipation rejection of independent claims 1 and 17, and has not provided sufficient evidence to maintain a prima facie obviousness rejection of independent claim 33.

Further, regarding claim 20, Applicants respectfully note that despite the Office Action's characterization, there has been no admission that the information disclosed in the Description of the Related Art section of the Specification is "Prior Art." And the Office Action has not provided any evidence that such information is prior art. Thus, Applicant's respectfully submit that the Office Action has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim.

Accordingly, respectfully request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. §§102 and 103.

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all

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pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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